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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,960	09/18/2003	Xiaoru Wang	82215ASMR	8319

7590 06/20/2006

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EXAMINER

SHOSHO, CALLIE E

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 06/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/665,960

Applicant(s)

WANG ET AL.

Examiner

Callie E. Shosho

Art Unit

1714

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 June 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☒ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1,3-7 and 9.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

Callie E. Shosho
Primary Examiner
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Attachment to Advisory Action

1. Applicants' amendment filed 6/5/06 has been fully considered but the amendment has not been entered given that it raises new issues that would require further consideration and search.

The amendment would raise new issues under 35 USC 112, first paragraph. Specifically, claim 1 has been amended to recite "wherein essentially no monomer is present in the aqueous pigment mixture". It is the examiner's position that this phrase fails to satisfy the written description requirement under 35 USC 112, first paragraph since there does not appear to be a written description requirement of the cited phrase in the application as originally filed, *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and MPEP 2163. It is noted that in the amendment filed 1/26/06, applicants amended claim 1 to recite "wherein no monomer is present in the aqueous pigment mixture". In light of this amendment, claim 1 was rejected under 35 USC 112, first paragraph as set forth in paragraph 3 of the office action mailed 4/11/06. In response, in the present amendment filed 6/5/06, applicants inserted the phrase "essentially" into claim 1, i.e. "wherein essentially no monomer is present in the aqueous pigment mixture". Thus, if the after-final amendment were entered, the amendment to claim 1 would raise new issues under 35 USC 112, first paragraph in light of the insertion of the phrase "essentially" which was previously not recited in claim 1.

Applicants argue that there is support for the phrase "wherein essentially no monomer is present in the aqueous pigment mixture" in the specification as originally filed especially on page 6, lines 1-6 of the present specification. This portion of the specification discloses process wherein first portion of the initiator is added to aqueous colorant mixture before introducing a

monomer mixture which is used to form the polymer phase of the colored composite particles.

Applicants argue that this portion of the present specification makes clear that no monomer can be present in the aqueous colorant mixture when the polymerization initiator is added.

However, while this portion of the present specification discloses that a portion of the initiator is added to aqueous colorant mixture before adding a monomer mixture, it is noted that this does not provide support to recite that there is “essentially no monomer” present in the aqueous colorant mixture. There is no disclosure regarding the presence or absence of monomer in the aqueous colorant mixture. While there is no disclosure in the specification as originally filed that the aqueous colorant mixture comprises monomer including the examples wherein no monomer is utilized in the aqueous colorant mixture, it is noted that as stated in MPEP 2173.05(i), the “mere absence of a positive recitation is not the basis for an exclusion.”

Applicants also point to page 6, lines 9-14 of the present specification which recites that the present invention uses a special sequence of adding the initiator. However, there is no disclosure in this portion of the specification that “essentially no monomer” is present in the aqueous colorant mixture. The recitation “wherein essentially no monomer is present in the aqueous pigment mixture” is a negative limitation and it is noted that the use of negative limitations introduces new concepts given that the express exclusion of certain elements implies the permissible inclusion of all elements not so expressly excluded.

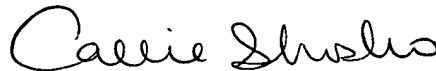
Further, it is noted that applicants’ amendment raises new issues under 35 USC 112, second paragraph. Specifically, claim 1 has been amended to recite wherein “essentially” no

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monomer is present in the aqueous pigment mixture. The scope of the claim is confusing because it is not clear what is meant by “essentially” no monomer or how much monomer this encompasses. Further, it is not clear how the phrase “essentially no monomer” is different than previously recited phrase “no monomer”.

Further, new claim 10 recites “wherein sequential addition of initiator to the pigment mixture essentially prior to adding monomer mixture”. The scope of the claim is confusing because it is not clear what “essentially” prior means.

Additionally, it is noted that the amendment would raise new issues that would require further search in light of newly added claim 10 which requires the sequential addition of initiator to the pigment mixture essentially prior to adding monomer mixture.


Callie E. Shosho
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CS
6/15/06